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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------------------------------------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/759,784 | 01/12/2001 | Cary Lee Bates | ROC920000007US2 | 9669 |
| 46296 | 7590 | 04/28/2005 | EXAMINER | |
| MARTIN & ASSOCIATES, LLC IBM INTELLECTUAL PROPERTY LAW DEPARTMENT DEPARTMENT 917, BUILDING 006-1 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829 | | | D AGOSTA, STEPHEN M | |
| | | ART UNIT | PAPER NUMBER | |
| | | 2683 | | |
| DATE MAILED: 04/28/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/759,784 | BATES ET AL. | |
| | Examiner | Art Unit | |
| | Stephen M. D'Agosta | 2683 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 March 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 18-21 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 29-31 is/are allowed.
- 6) Claim(s) 18-21 is/are rejected.
- 7) Claim(s) 27-28 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|-------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 18-21 have been considered but are moot in view of the new ground(s) of rejection.

1. Claims 18-21 and 27-31 are pending.

2. The primary examiner believes claim 27 is a novel feature and has objected to this claim. He has also allowed claims 29-31 since claim 29 recites this novel feature.

3. The primary examiner notes that the independent claims have been amended to state "one defined geographical region defined by a user of the portable phone each defined geographical region having corresponding phone parameters...". Since the claim does not specifically state "how" the user defines the region, this is open to interpretation (as opposed to claim 27 which states that "the user of the portable telephone uses the position detector located in the phone to define the defined geographical region"). For example, the user could contact someone, maybe the phone company or network administrator, and tell them to create/define a certain region for them. Hardouin is used as prior art since he teaches a system administrator defining regions that provide special wireless unit operations. Hence the user can contact said system administrator to have them define an area/region for special operations much like a user can contact a Help Desk and/or customer service to add/change features.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Syed and Dennison and further in view of Hardouin EP0876071.

As per **claim 18**, Syed teaches a telephone system (title, abstract, figure 1) comprising:

- (A) a portable phone (figure 1, #11);
- (B) at least one geographical region (Syeds teaches routing a call based upon the geographical location/region of the user's mobile in relation to a wireline phone),
- (C) a mechanism that receives the position of the portable phone from the position detector, and that determines from the position of the portable phone whether the portable phone enters or exits a defined geographical region (Syed's figure 1, #27 is the "call routing function" that has knowledge of the mobile and routes calls to the wireline if/when the location-finding system #25 identifies that the mobile is within a "region" near the wireline, see C2, L35-48); and
- (D) a call router that routes a telephone call according to the phone parameters for a region (C2, L35-48 teaches routing a call to a wireline phone when the "if the portable phone is within a predetermined physical-relationship with the second phone").

But is silent on portable phone that includes a position detector that detects the position of the portable phone AND each defined geographical region having corresponding phone parameters that determine how a call is rung and routed AND a call router that rings a phone according to parameters of the region as defined by a portable user.

Dennison teaches the phone having a GPS receiver on it to determine it's own position (abstract) instead of Syed's design whereby the network determines the phone's position. One skilled would use either design such that the position of the phone can be determined.

Hardouin teaches determination of a wireless handset's location and audio/vibration alerting based on location (abstract, "users may choose to specify areas designated by the system administrator for audio alerting or vibration alerting" and "the system administrator may determine different alerting information for different areas of the building). Hardouin's teachings provide a method for a system administrator to define a region per a portable user's specifications such that it receives special control/operations depending on geographical location (figures 1-2 and C2, L23-54).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Syed, such that portable phone that includes a position detector AND each defined geographical region having corresponding phone parameters that determine how a call is rung and routed AND a call router that rings a phone according to parameters of the region as defined by a portable user, to provide means for determining the position of the phone (via GPS phone receiver) and ringing the phone(s) in a specific manner based upon geographical location as specified by the user to accommodate their needs (eg. to alert the user that they are near a mobile/wireline phone that the call can be routed to).

As per **claim 19**, the combination teaches claim 18 **but is silent on** wherein the position detector comprises a global positioning system (GPS) sensor.

Dennison teaches the phone having a GPS receiver on it to determine it's own position (abstract) instead of Syed's design whereby the network determines the phone's position. One skilled would use either design such that the position of the phone can be determined.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Syed/Dennison/Hardouin, such that a GPS sensor is

used, to provide a more accurate location determination than the network's location determining system taught by Syed.

As per **claim 20**, the combination teaches claim 18 wherein the call router in (D) resides in a telephone company network that is coupled to the portable phone (figure 1 #27 is the MSC/HLR/VLR switching system/router that routes the calls based on the location finding system #25 and has knowledge if/when the user's mobile is in a geographical region near a specific wireline phone, abstract);

But is silent on at least one geographical region in (B) and the mechanism in (C) reside within the portable phone.

For (B): Hardouin teaches determination of a wireless handset's location and audio/vibration alerting based on location (abstract, "users may choose to specify areas designated by the system administrator for audio alerting or vibration alerting" and "the system administrator may determine different alerting information for different areas of the building). The ability for the phone and/or system to store the region data is inherent since both the phone and system comprise processors with memory.

For(C): Dennison teaches the mobile phone having a GPS receiver on it (abstract) which inherently requires the phone to know it's geographical location/region.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Syed/Dennison/Hardouin, such that at least one geographical region in (B) and the mechanism in (C) reside within the portable phone, to provide means for offloading processing requirements from the system onto the mobile phone as well as for storage of data on the phone if/when the network is unavailable to receive any/all phone configuration parameters from the user.

As per **claim 21**, the combination teaches claim 18 and the call router in (D) reside in a telephone company network that is coupled to the portable phone (figure 1 #27 is the MSC/HLR/VLR switching system/router that routes the calls based on the location finding system #25 and has knowledge if/when the user's mobile is in a geographical region near a specific wireline phone, abstract);

but is silent on wherein the portable phone communicates its detected position to the call router, and wherein the at least one geographical region in (B), and mechanism in (C), reside in the portable phone.

For (B) and (C): Dennison teaches a phone with GPS receiver (abstract) that would communicate it's position to the network/call router since GPS is more accurate than most/all network location-determining systems.

Hardouin teaches a system level table (figures 4 and 5) that resides in phone network (eg. BSC/éTS).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Syed/Dennison/Hardouin, such that the portable phone communicates its detected position to the call router, and wherein the at least one geographical region in (B), and mechanism in (C), reside in the portable phone, to provide means to offload processing requirements from the system onto the mobile phone (so that the phone initiates the process whereby it determines when it is in a region that may require the call router to route wireless calls to a wireline phone instead of the network having to do the processing for this operation for all phones in it's region).

Allowable Subject Matter

Claims 29-31 allowed. These claims recite that the user defines the geographic region using their portable handset/device.

Claims 27-28 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. These claims recite novel material in that the user defines the geographic region with their portable handset/device.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta
PRIMARY EXAMINER
4-14-2005

